

REMARKS

Reconsideration and allowance of the subject application is respectfully requested. Upon entry of this Amendment, claims 1-16 are all the claims pending in the application.

Finality of the Office Action

The Examiner has made this Office Action Final. Applicant's representative called the Examiner for clarification, and during the discussion, the Examiner argued that by adding new claims to the application, Applicant necessitated the new ground of rejection. However, this should not serve as a basis for a final rejection over previously pending claims over new prior art, as the Examiner has done. The subject matter of claim 1 was previously before the Examiner and thus the Examiner could have applied Haneda against claim 1 in the first office action. However, the Examiner did not do so. The new rejection, on a final basis, is highly prejudicial to Applicant, and thus the finality of the rejection is clearly premature under MPEP §706.07(a). Applicant therefore respectfully requests the Examiner to withdraw the finality of the Office Action since the finality of the Office Action is improper.

Claim rejections -- 35 U.S.C. § 102

Claims 1-8 stand rejected under 35 U.S.C. § 102(e) as allegedly being unpatentable over Nihei, which is previously of record.

In the "Response to Arguments" section of the Final Office Action (see pg. 2), the Examiner asserts that the template image data of Nihei corresponds to the claimed "combining

data required for generating the composite image”, as set forth in, for example, claim 1.

However, Applicant respectfully disagrees with the Examiner’s position.

At col. 5, line 55 to col. 6, line 4, Nihei describes that the template image data represents an image used as a background image. Thus, the template image of Nihei is, at best, an image which is combined to form the composite image, as set forth in claim 1. If the template (background) is read as the combining data, then there is no joining of plural original images. Moreover, at col. 6, lines 1-4, Nihei describes that a user may select “NO BACKGROUND IMAGE”, in which case the template image selection processing is skipped, and no template image is selected. Thus, the template image cannot correspond to the claimed combining data, which is “required for generating the composite image”, as set forth by claim 1. If the template data, comprising the background image, is not selected, then the operation would lack the joining of “plural original images”, as claimed. Applicant respectfully submits that claim 1 is patentable over Nihei for these reasons.

Claims 2-8 are patentable based on their respective dependencies.

Claims 1 and 9-12 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,819,449 to Haneda. Applicant respectfully traverses this rejection.

For example, claim 1 recites the feature of a selection process means for executing a selection process based on an output destination device specified as the destination for image transmission. The Examiner maintains that this feature is met by Haneda at col. 15, line 46 to col. 19, line 47. However, the only portion of these lines that refers to printing is col. 19, lines 32-47. At these lines, however, Haneda only discloses that a printer 37 prints the composite

image using the composite image data, where the template image data and mask data are also used. Thus, Haneda does not show a selection process means, much less a selection process means which selects data based on an output destination device specified as the destination for image transmission, as set forth by claim 1. Applicant therefore respectfully submits that claim 1 is therefore patentable over Haneda for this reason.

Claims 9-12 are patentable based on their respective dependencies.

New claims

Applicant herein adds claims 13-16 in order to claim additional features of the invention. These claims are patentable over the art of record based on their dependencies.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.116
U.S. Appln No. 09/987,076

Q66742

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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